

### **REMARKS**

This amendment responds to the Office Action mailed October 7, 2005. Accordingly, applicants respectfully submit that this response is being timely filed. Claims 1-15 are still pending.

### **SPECIFICATION**

A new abstract complying with the requirements of MPEP §608.01(b) has been submitted. Per the office action, paragraph 15 of the “Detailed Description of the Preferred Embodiments” has been amended. Reconsideration is respectfully requested.

### **CLAIM REJECTIONS**

#### **CLAIM REJECTION- CLAIM 11 – 35 U.S.C. § 112**

Claim 11 has been amended as suggested by the Office Action. Reconsideration is respectfully requested.

#### **35 U.S.C. § 102(b) REJECTION – Claims 1-3 and 11**

The Office Action rejects Claims 1-3 and 11 as being anticipated by Hoffman (US 6,523,986). Applicants respectfully traverse.

For Claims 2 and 3, the Office Action states “Hoffmann discloses an illumination system having...a lens buffer (as recited in Claim 2), Figure 1, reference number 15.” Office Action, p. 6. However, Hoffmann discloses that reference numbers 15 are “rabbets.” Hoffmann, Col. 3, l. 9. A rabbet is a “rectangular groove made to hold two pieces together.” See Exhibit 1, “rabbet” dictionary definitions, attached. This definition

is supported by Hoffmann's specification as the rabbets 15 are used to hold the translucent guard 5 in section 1. Hoffmann, Col. 3, ll. 23-28.

Conversely, Claim 2 requires a "lens buffer." A buffer is defined as, *inter alia*, "a cushion-like device that reduces shock due to contact." See Exhibit 2, "buffer" dictionary definition, attached. The specification for the present application also identifies the lens buffers 250 as "impact buffers 250." Application, ¶5. The lens buffers 250 preferably act to cushion the step of patrons on the lens 240. In particular, the specification describes a preferred embodiment of the lens buffers 250 as having "a hardness less than the base extrusion ranging from 85-95 Duro on the Shore OO hardness scale, preferably 90 Duro. PVC of 90 Duro is generally considered 'flexible' PVC." Application, ¶5. Moreover, the application states that the lens buffer preferably further acts as "gaskets to seal against the sides 212 of the channel 217 and the lens 240." Application, ¶6.

Hoffmann's rabbets 15 appear to be made of the same material and have the same hardness as the remainder of the section 1 disclosed. No disclosure is provided by Hoffmann indicating that the rabbets 15 act to provide a cushion or gasket for the translucent guard 5. Accordingly, Hoffman does not anticipate each and every element of Claim 2 or its dependent, Claim 3. Reconsideration is respectfully requested.

For Claims 1 and 11 as amended, the Office Action fails to disclose flanges having a second hardness less than a base with a first hardness. The Office Action states elsewhere that selection of a prior art material on the basis of its suitability for its

intended purpose is within the level of ordinary skill and cites *In re Leshin*, 125 USPQ 416 (CCPA 1960) and *Sinclair & Carroll Co. v. Interchemical Corp.*, 65 USPQ 297 (1945). However, both *Leshin* and *Sinclair* refer only to the basic selection of known materials in general, e.g. selecting plastic for the container in *Leshin* or in *Sinclair*, *supra*, the inventor merely selected an ink from a catalog based on the catalog description. Claims 1 and 11 require that materials, such as PVC, of varying hardness be used to make particular components that are combined in a specific manner and for a purpose not disclosed or suggested in the prior art. Hoffman discloses the use of PVC but makes no mention of varying hardness amongst components. There is nothing in Hoffmann or Marcus (U.S. Pat. No. 6,074,074) that discloses or suggests that the flanges and base section (or a lens buffer) should have differing hardness. Accordingly, the references cited fail to disclose each and every element of Claims 1 and 11 and therefore do not satisfying the requirements of §102. Reconsideration is respectfully requested.

### **35 U.S.C. §103(a) REJECTION – Claims 4-10**

The Office Action rejects Claims 4-9 under 35 U.S.C. §103(a) as being unpatentable over Hoffman. As stated above, the Office Action claims that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use polyvinyl chloride (PVC) as the material of the base extrusion (as recited in Claim 6), a PVC material having a hardness of at least 94 Duro on the Shore 00 scale to form the base of HOFFMANN (as recited in Claim 7), or softer PVC material for the flanges than that of

the base (as recited in Claim 8), since it has been held by the courts that selection of a prior art material on the basis of its suitability for its intended purpose is within the level of ordinary skill.” Office Action, p. 13 (citations omitted). Applicants respectfully traverse.

As discussed above, Applicants’ combination of components of differing hardness is not disclosed by either Hoffmann or Marcus. There is nothing in Hoffmann or Marcus that discloses or suggests that the flanges and base section (or a lens buffer) should have differing hardness. Moreover, neither Hoffmann nor Marcus disclose the specific hardness of specific components as done in Claims 4, 5, 7 or 8 of the present application. The Federal Circuit has admonished, “To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Moreover, the Federal Circuit explained “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992). There is no suggestion in the prior art that specific components of different hardness be used to obtain the desired effects disclosed in the present application. Accordingly, Applicants respectfully request reconsideration.

With regard to Claim 10, in addition to the arguments raised above, the Office Action claims, “It would have been obvious to one of ordinary skill in the art at the time

the claimed invention was made to co-extrude the base and flange extrusions, since it has been held that patentability of a product does not depend on its method of production.” Office Action, p. 18. Applicants respectfully traverse.

The present claim is not merely a “product-by-process” claim. The elements of independent Claim 6 are entirely structural and directed to a specific product. The sole “process” element in Claim 10 is the “co-extruded” element. The Court of Customs and Patent Appeals explained, “it is well established that product claims may include process steps to wholly or partially define the claimed product. *See In re Brown*, and the cases cited therein. To the extent these process limitations distinguish the product over the prior art, they must be given the same consideration as traditional product characteristics.” *In re Luck*, 177 USPQ 523, 525 (C.C.P.A. 1973). Accordingly, a *prima facie* case of obviousness requires that co-extrusion be present in the references cited. The Office Action admits that Hoffmann does not disclose co-extrusion. Office Action, p. 18. Thus, Applicants respectfully request reconsideration.

**35 U.S.C. §103(a) REJECTION – Claims 12, 14 and 15**

The Office Action rejects Claims 12, 14 and 15 under 35 U.S.C. §103(a) as being unpatentable over Hoffman in view of Marcus (U.S. Pat. App. 2002/0110000.) With regards to Claims 12 and 14, as stated above, Claim 11 is patentable over the prior art and therefore its dependent claims are patentable as well. Additionally, with regard to Claim 15, the Office Action claims Marcus discloses a module where the first and second snap

tabs are separated by differing support lengths. Office Action, pp. 22-23. Applicants respectfully traverse.

The only portion of Marcus cited by the Office Action against this portion of Claim 15 is Figure 3. Office Action, p. 23. However, there is no indication in Figure 3 or the specification of Marcus that the distances between the tabs 8 have any variance. As explained in the present application, the distances between the tabs 32 of a preferred embodiment shown in Figures 8 and 9, namely reference numbers 22 and 23, are used to insure that the circuit board 20 is installed on the electrical leads with proper polarity. Application, p. 7. Given that the second shell 10 in Marcus is merely a cover, its installation on the device shown has no effect on the polarity as the leads are already electrically connected to the LEDs before the second shell 10 is installed.

There is no disclosure by Marcus regarding the insurance of installing the device disclosed with proper polarity in general or specifically varying distances between snap tabs to guide proper installation. Claim 15 has been amended to clarify the use of differing lengths between the snap tabs. Applicants respectfully request reconsideration.

#### **CLAIM OBJECTION**

The Office Action states that Claim 13 contains allowable subject matter but depends from a rejected base claim. Per the arguments raised above with regards to the base claim, Applicants respectfully request reconsideration.

**CONCLUSION**

Applicants believe that this case is in good condition for allowance, and a Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned, who will cooperate in any appropriate manner to advance prosecution.

I hereby certify that the above correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 6, 2006.

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Respectfully submitted,



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